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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

TUC920000072US1

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on September 8, 2005

Signature

Typed or printed
name

Reena Mendez

Application Number

09/757,971

Filed

01/10/01

First Named Inventor

DIMITRI ET AL.

Art Unit

3653

Examiner

Shapiro, Jeffrey

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐ applicant/inventor.☐ assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)☒ attorney or agent of record.
Registration number 45,625☐ attorney or agent acting under 37 CFR 1.34.

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NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

☒*Total of 1 forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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Applicants' claims 1-22 are pending. Claims 23 and 24 have been withdrawn.

Applicants' claims 1-22 stand rejected under 35 USC 103(a) as being unpatentable over Motoyama et al. (U.S. Pat. No. 6,022,180) in view of Kanetsuku et al (U.S. Pat. No. 6,449,223), further in view of Ostwald et al. (U.S. Pat. No. 6,262,863) and still further in view of Mobley (U.S. Pat. No. 6,123,029).

Applicants' independent claims 1 and 10 recite, *inter alia*, a first rail system comprising a set of rails disposed along a first axis; one or a plurality of accessors comprising, *inter alia*, a lifting servo section which moves bidirectionally on a pillar along a second axis, where the first axis is perpendicular to the second axis; a second rail system comprising two parallel sets of rails disposed along a third axis, where the third axis is perpendicular to both the first axis and the second axis; and a moveable set of rails that can be moved bidirectionally along the second rail system.

Applicants' independent claim 19 recites, *inter alia*, a first media storage library having a first rail system comprising a set of rails disposed therein along a first axis, one or a plurality of accessors comprising, *inter alia*, a lifting servo section which moves bidirectionally on a pillar along a second axis, where the first axis is perpendicular to the second axis; a third rail system comprising two parallel sets of rails disposed along a third axis, where the third axis is perpendicular to both the first axis and the second axis; and a moveable set of rails that can be moved bidirectionally along the third rail system.

Applicants' second rail system recited in claims 1 and 10, and Applicants' third rail system recited in claim 19, comprise two parallel sets of rails, and therefore, comprise four (4) rails. For example, Applicants' FIGs. 7 and 10 recite a first set of rails 80a and 80b in

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combination with a second set of rails 85a and 85b. Applicants' FIG. 8 shows that same two parallel sets of rails.

Motoyama et al. teach a robotic accessor capable of moving horizontally along a rail system in a media library, where that accessor comprises a lifting servos section which moves along a vertical pillar. Kanetsuku et al. teach a library apparatus comprising "a storage rack, a deck, and an accessor and is constructed by coupling a plurality of lockers in which a traveling passage for the accessor is formed to penetrate them as well as the first-mentioned library apparatus, wherein sheet metal columns having a standardized structure are set vertically at corner portions of the locks, and a plane reference plate having a vertical surface parallel to the coupling directions of the plurality of lockers . . ." Col. 2 / Line 65 - Col. 3 / Line 4.

As a preliminary matter, Applicants respectfully submit that the Examiner's combination of Motoyama et al. with Ostwald et al. is improper. There is no suggestion in Motoyama et al. to combine their teachings with Ostwald et al. Moreover, Ostwald et al. teach away from Motoyama et al. and from Kanetsuku et al., and from Applicants' claims, for the reasons set forth on Pages 15 and 16 in Applicants' Amendment C filed December 9, 2004.

Even if the combination of Motoyama et al. and Ostwald et al. were proper, those combined teachings do not teach or suggest all the elements of Applicants' claims 1, 10, and 19. Ostwald et al. teach a media library comprising robots which move along a rail system comprising parallel rails 121, 122, 123, 134, 125, and 126, where each of those rails runs horizontally, i.e. along a first axis, in combination with moveable rails 141A and 141B, where those moveable rails moves vertically, i.e. along a second axis. Ostwald et al. do not teach moving the moveable rails on any sort of rail system. Rather, Ostwald et al. teach use of a

vertical drive motor 133 and a belt drive 143. Col. 5 / Lines 35-39. Ostwald et al. nowhere teach or suggest disposing moveable rails 140 on a rail system. This being the case, Ostwald et al. nowhere teach disposing moveable rails on a rail system comprising two parallel sets of rails, as recited in Applicants' claims 1, 10, and 19.

The Examiner incorrectly posits, *inter alia*, that "Ostwald appears to further read on applicant's independent claims." First sentence on Page 6 of the March 8, 2005 Office Action. In the next paragraph on Page 6, the Examiner asserts that Ostwald et al. teach "a moveable rail system (140) wherein each moveable set of rails can be moved bidirectionally along a third axis, where said third axis is perpendicular to both said first axis and said second axis." The Examiner then, however, defines that "third axis" in two different, and contradictory, ways:

Note that the **third axis is up and down** with respect to the vertical column of the [sic] and that the stationary rails (121) allow movement perpendicular to the direction in which the moveable rails move, and that **a third axis exists along which the cartridge picker moves in and out of the storage cell along another functionally equivalent movement axis.**

First full paragraph on Page 6 in the March 8, 2005 Office Action (emphasis added). Ostwald et al, nowhere teach or suggest an automated data storage system comprising a moveable set of rails disposed on a rail system comprising two parallel sets of rails.

Mobley teaches "an improved truck-train system for transporting both passengers and freight by railway." Col. 1 / Lines 5-9. As a preliminary matter, Applicants respectfully submit that the Examiner improperly combines the teachings of Motoyama et al. and Mobley, because Mobley does not comprise analogous art.

"In order to rely on a reference as a basis for rejection of an applicant's invention, the reference must either be in the field of applicant's endeavor or, if not, then be reasonably

pertinent to the particular problem with which the inventor was concerned.” MPEP 2141.01(a). “A reference is reasonably pertinent if, even though it may be in a different field from that of the inventor’s endeavor, it is one which, because of the matter with which it deals, logically would have commended itself to an inventor’s attention in considering his problem.” MPEP 2141.01(a); *In re Clay*, 966 F.2d 656, 659 23 USPQ2d 1058, 1060-61 (Fed.Cir. 1992).

Mobley is clearly directed to railroad systems. Applicants’ claims are directed to an automated data storage library. The Examiner makes no showing that Mobley would have commended itself to one skilled in the art of making or using automated data storage libraries.

Mobley teaches a switching ramp 75, where that switching ramp comprises a plurality of rails 35, where ramp 75 comprises concrete slab 76, and where “slab 76 is adapted for rolling movement within the pit structure 80 being mounted on a plurality of railroad bogies devices 72 or other similar devices . . .” Col. 10 / Lines 25-28. Mobley teaches a moveable set of rails, namely switching ramp 75. Mobley nowhere teaches or suggests, however, disposing that switching ramp on a rail system comprising two parallel sets of rails.

Therefore, even if Mobley did comprise analogous art, Mobley nowhere teaches or suggests a moveable set of rails disposed on a rail system comprising two parallel sets of rails. Even if the combination of Motoyama et al. and Mobley were proper, those combined teachings do not teach or suggest teaches or suggests an automated data storage system comprising a moveable set of rails disposed on a rail system comprising two parallel sets of rails, as recited in Applicants’ claims 1, 10, and 19.

Moreover, even if the combination of Motoyama et al., Kanetsuku et al., Ostwald et al., and Mobley were proper, those combined teachings do not teach or suggest an automated data

storage system which comprises a moveable set of rails disposed on a rail system comprising two parallel sets of rails, as recited in Applicants' claims 1, 10, and 19.

In addition, even if the combination of Motoyama et al., Kanetsuku et al., Ostwald et al., and Mobley were proper, those combined teachings do not teach or suggest an automated data storage system which comprises a first rail system comprising a set of rails disposed along a first axis; one or a plurality of accessors comprising a lifting servo section which moves bidirectionally on a pillar along a second axis, where the first axis is perpendicular to the second axis; a second rail system comprising two parallel sets of rails disposed along a third axis, where the third axis is perpendicular to both the first axis and the second axis; and a moveable set of rails that can be moved bidirectionally along the second rail system, as recited in Applicants' claims 1, 10, and 19.

In summary, Applicants respectfully submit that the Examiner improperly combines the teachings of Motoyama et al. and Ostwald et al. In addition, the Applicants further respectfully submit that the Examiner improperly combines the teachings of Motoyama et al. and Mobley. Moreover, the Applicants further respectfully submit that even if the combination of Motoyama et al., Kanetsuku at al., Ostwald et al., and Mobley, were proper, those combined teachings fail to teach or suggest all the elements of Applicants' independent claims 1, 10, and 19.

Claims 2-9 depend, directly or indirectly, from claim 1. Claims 11-18 depend, directly or indirectly, from claim 10. Claims 20-22 depend, directly or indirectly, from claim 19.

Applicants respectfully submit that even if the combination of Motoyama et al., Kanetsuku at al., Ostwald et al., and Mobley, were proper, those combined teachings fail to teach or suggest all the elements of Applicants' claims 1 through 22, inclusive.